APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,753	12/13/2004	Richard L Andrews	5468-102US/P28047-A-USA	1334

7590 08/10/2007

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EXAMINER
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ART UNIT	PAPER NUMBER
2178	

MAIL DATE	DELIVERY MODE
08/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/517,753	ANDREWS ET AL.
	Examiner	Art Unit	
	CESAR B. PAULA	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>18 October 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1,2,6-10,14-18 and 22-28</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-2, 6-10, 14-18, and 22-28</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of: ᵢ

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

1.   This action is responsive to the RCE amendment filed on 10/18/2006.

This action is made Non-Final.

2.   In the amendment, claim 28 has been added. Claims 1-2, 6-10, 14-18, and 22-28 are

pending in the case. Claims 1, 9, and 17 are independent claims.

Priority

3.   Acknowledgment is made of applicant's claim for domestic priority under 35

U.S.C. 119(e), and based on U.S provisional application # 60/390,098 filed on **6/19/2002**.

Drawings

4.   The drawings filed on 12/13/2004 have been accepted by the Examiner.

Claim Objections

5.   The objections of claims 1-2, 6-10, 14-18, and 22-27 have been withdrawn as

necessitated by the amendment.

Claim Rejections - 35 USC § 112

6.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making
and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
contemplated by the inventor of carrying out his invention.

7.   Claims 1-2, 6-10, 14-18, and 22-27 remain rejected under 35 U.S.C. 112, first paragraph,

as failing to comply with the enablement requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to enable one skilled in the art to

which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1, 9, and 17 recite "enhanced HTML pages, containing said source HTML files",

"enhanced HTML pages, containing said source HTML file", "enhanced HTML pages,

containing said source HTML files", in lines 24-25, 22-23, and 23 respectively. The Examiner

has yet to find in the instant specification enhanced pages containing HTML files. What is well

known in the art, is the inclusion of HTML web pages within HTML source files or including

content within a webpage. The specification does not appear to support the citation in the claims.

8.   The rejections of claims 1, 9, and 17 for reciting the limitation "said template specifying

characteristics of the <u>visual appearance of the electronic document adjacent to said source</u>

<u>HTML file</u>" in lines 18-19, have been withdrawn as necessitated by the amendment.

9.   Claims 1-2, 6-10, 14-18, and 22-27 are rejected under 35 U.S.C. 112, first paragraph, as

failing to comply with the enablement requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to enable one skilled in the art to which it

pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1,

9, and 17 recite "*substitution code is automatically rendered by said rendering means as a string*

sequentially identifying all of said pages nodes having a like hierarchical substitution code",

"*substitution code is automatically rendered as a string sequentially identifying all of said pages nodes having a like hierarchical substitution code*", in last parag.. The Examiner has not found in the instant specification, a rendered string which sequentially identifies all the pages having a like hierarchical structure. The specification describes a string, which has code for each of the document's page nodes that are in a certain level (page 10, parag.1). This is not the same as a rendered string, which identifies all page nodes having like substitution code. The specification does not appear to support the citation in the claims.

10.   Claims 1-2, 6-10, 14-18, and 22-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1, 9, and 17 recite "*said source document incorporatable into a website and usable independent of external server-based technology*", in the preamble. The Examiner has not found in the instant specification, the source document, which is published on a website (on the Internet), and is used independent of an external server. The specification does not appear to support the citation in the claims.

11.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12.   Claims 1-2, 6-10, 14-18, and 22-27 are rejected under 35 U.S.C. 112, second

paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject

matter which applicant regards as the invention.

13.   Claims 1, 9, and 17 recite *"said source document incorporatable into a website and*

usable independent of external server-based technology", in the preamble. There appears to be a

contradiction in this limitation, because how can a document that is published on the Internet, not

be dependent on a server that is to store such website?. By definition, webpages are dependent on

an external web server. They are published on a server on the Internet, so that they are dependent

on the server giving Internet users access to such website.

14.   The rejections of claims 1, 9, and 17 reciting the limitation "said HTML file" in line 19,

have been withdrawn as necessitated by the amendment.

15.   The rejections of claims 1, 9, and 17, which recite the limitation "said template specifying

characteristics of the <u>visual appearance of the electronic document adjacent to said source</u>

<u>HTML file</u>" in lines 18-19, have been withdrawn as necessitated by the amendment.

Claim Rejections - 35 USC § 103

16.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

17.   Claims 1-2, 6-10, 14-18, and 22-28 are rejected under 35 U.S.C. 103(a) as being

unpatentable over DeRose et al (Pat.# 6,167,409, 12/26/2000) , in view of Bobrow et al (USPub.

No. 2002/0029232 A1, 3/7/2002, filed on 11/14/1997).

Please find the rejection of the pending claims below in light of the 35 USC 112

rejections above.

Regarding independent claim 1, DeRose teaches the creation and generation of markup

language documents, such as HTML, which contain cross-referencing links--hierarchical

navigational elements-- and linear navigational elements, such as table of contents, bookmarks,

etc (col. 7, lines 3-30, col. 8, lines 17-38, and col.11, lines 15-62, col.13, lines 57-67).

Moreover, DeRose teaches a computer system for the creation and generation of markup

language documents in a table of contents organization, from a source documents--books,

manuals, etc, in a format such as SGML, into another target format, such as HTML. The table

of contents is used for downloading the document is section--*series of HTML files*-- (col. 7,

lines 3-30, and 40-67, col.11, lines 4-67).

Moreover, DeRose teaches the automatic creation of a tree representing a hierarchical

relationship between the markup document and its elements--*at least two hierarchical levels

established.* The tree divides the document up into many sections, subsections, etc--page nodes

which are arranged into a sequential ordering in the same order as that of a printed manual. —
a source document comprising sequentially numbered source pages; said sequential ordering
relating each of said source HTML files in the same order as said corresponding, sequentially
numbered source pages of said source document (col. 8, lines 1-67, col.7, lines 58-67, and
fig.3-4).

Moreover, DeRose teaches the creation, and storing of a stylesheet(s)-- *a means for*
storing said templates-- for describing the display format of the documents -- *a templater*
means for defining a template, said template specifying a visual appearance of the electronic
document framing said source HTML file, said template comprising at least one document
layout elements, said layout out elements comprising at least one substitution code (col. 13,
lines 21-col.16, line 67).

Furthermore, DeRose teaches the conversion of the source SGML documents into HTML
documents, and the rendering in a client computer system using the stylesheets, the code, and
the documents hierarchical relationships. The code is used for substituting the codes with
information for paginating (in a sequential manner) the document pages, which are
downloaded using links presented in a hyperlinked table of contents-- *a rendering means for*
creating final, static enhanced HTML pages, containing said source HTML files, to be
displayed, said rendering means employing said template, said hierarchical relationships, said
document layout elements and said source HTML files, and wherein said hierarchical
substitution code is automatically rendered by said rendering means as a string sequentially
identifying all of said pages nodes having a like hierarchical substitution code, thereby
automating creation of an electronic document that is representative of said source document

suitable for incorporation in a web-site. (col. 7, lines 3-67, col.11, lines 4-14, col. 13, lines 24-67, and col.17, lines 26-67). DeRose fails to explicitly disclose *a printed source document.* However, Bobrow teaches the conversion of printed documents into html versions (0014). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine DeRose and Bobrow, because of all the reasons found in Bobrow above including the capturing and preservation of the printed document layout.

Regarding claim 2, which depends on claim 1, DeRose teaches a computer pointer device or mouse, which as was well known in the art is used for dragging and dropping document objects (col. 7,lines 30-67).

Regarding claim 6, which depends on claim 1, DeRose teaches the translation, and rendering of the converted or final documents is done over WWW--*Internet*-- (col. 7, lines 3-41).

Regarding claim 7, which depends on claim 6, DeRose teaches the rendering of the converted or final documents is done using a browser--*Internet reader* (col. 7, lines 16-30).

Regarding claim 8, which depends on claim 1, DeRose teaches the rendering of structured documents, such as manuals, electronic books (col. 7, lines 16-30, 57-67).

Claims 9-10, 14-16 are directed towards a method for implementing the steps found in

claims 1-2, 6-8 respectively, and are therefore similarly lack novelty.

Claims 17-18, 22-24 are directed towards a computer program product for storing, and implementing the steps found in claims 1-2, 6-8 respectively, and are therefore similarly lack novelty.

Regarding claim 25, which depends on claim 1, DeRose teaches the conversion of the source SGML documents into HTML documents into table of contents using the documents hierarchical relationships -- *said source document further comprises a table of contents and wherein said hierarchical relationships correspond to said table of contents* (col. 7, lines 3-67, col.11, lines 4-14, and col.17, lines 10-67).

Claims 26-27 are directed towards a method for implementing the system found in claim 1, and are therefore similarly rejected.

Regarding independent claim 28, DeRose teaches the creation and generation of markup language documents, such as HTML, which contain documents a table of contents, cross referencing other document contents as files, and arranged in a sequential ordering in the same order as that of a printed manual -- *two or more sequentially numbered pages and a table of contents, each of said HTML files representing one of said sequentially numbered pages of said source document* (col. 7, lines 3-30, 58-67, col. 8, lines 1-67, and col.11, lines 15-62).

In addition, DeRose teaches the automatic creation of a tree representing a hierarchical

relationship between the markup document and its elements. The tree divides the document up

into many sections, subsections, parent, children, sibling, etc--page nodes which are arranged

into a sequential ordering in the same order as that of a printed manual. — *associating said*

two or more HTML files with sequentially ordered page nodes, and wherein said page nodes

may further comprise parent nodes, a child nodes and a sibling nodes (col. 8, lines 1-67, col.7,

lines 58-67, and fig.3-4).

Further, DeRose teaches the creation and generation of markup language documents,

such as HTML, which contain intra and inter document cross-referencing links--hierarchical

navigational elements-- and linear navigational elements, such as table of contents, bookmarks,

etc-- *processing said two or more HTML files to produce a navigation-enhanced HTML*

document having an hierarchical navigational relationship between said two or more HTML

files, said hierarchical navigational relationship defined using said parent nodes, said child

nodes and said sibling nodes, and a linear navigational relationship between said two or more

HTML files, linear navigational relationship being defined using said sequentially ordered

page nodes; (col. 7, lines 3-30, col. 8, lines 17-38, and col.11, lines 15-62, col.13, lines 57-67).

Furthermore, DeRose teaches the creation, and storing of a stylesheet(s) for describing

the display format of the documents, including header, footers, pagination, copyright info, etc -

- *processing said navigation-enhanced HTML document to produce a navigation-and-*

appearance-enhanced HTML document wherein each page of said navigation-and-

appearance-enhanced HTML document comprises one of said HTML files framed by a

template(col. 13, lines 21-col.16, line 67). DeRose fails to explicitly disclose *providing a*

source document, said source document comprising a paper document, converting said source

document to two or more HTML files. However, Bobrow teaches the conversion of printed documents into html versions (0014). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine DeRose and Bobrow, because of all the reasons found in Bobrow above including the capturing and preservation of the printed document layout.

Response to Arguments

18.   Applicant's arguments filed 10/18/2006 have been fully considered but they are not persuasive. Regarding claims 1, 9, and 17, the Applicant submits that DeRose nowhere shows or teaches the generation of html documents that can be viewed independent of external server-baseed technology (page 10, parag.1). The Applicant is directed towards the 35 USC 112 rejection above concerning this limitation.

Further, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claims 2, 6, 8-10, 14-16, 18, and 22-27 depend on claims 1, 9, and 17, therefore are rejected at least based on the rationale established above.

Conclusion

I.   Any inquiry concerning this communication or earlier communications from the

Examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The

Examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m.

(EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please

allow at least one business day.

Information regarding the status of an application may be obtained from the Patent

Application Retrieval (PAIR) system. Status information for published applications may be

obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

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Or faxed to:
- **(571)-273-8300** (for **all** Formal communications intended for entry)

**CESAR PAULA
PRIMARY EXAMINER**
8/7/2007